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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,475	01/28/2004	Dean E. Meyer	MDG-006CIP	5070

7590 02/08/2007  
Daniel J. Deneufbourg Esq.  
37 Tuttle Ave  
Clarendon Hills, IL 60514

EXAMINER
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LARSON, JUSTIN MATTHEW

ART UNIT	PAPER NUMBER
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3782

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/767,475

Applicant(s)

MEYER, DEAN E.

Examiner

Justin M. Larson

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3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5-9,12,15,17-19,21-27 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☐ Claim(s) 1,5-9,12,15,17,18,21-27,30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 20070122.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action includes newly introduced grounds of rejection for subject matter that was previously indicated allowable, thereby making this action **Non-Final**.

#### ***Double Patenting***

2. Claims 1, 5, 6, 7, 8, 15, and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 7, 9, 12-26, 19, 21, and 24 of copending Application No. 10/767,482. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Application No. 10/767,482 contain all of the structure recited in the above-mentioned pending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specifically, the structural features of pending claims 1, 5, 7, 8, 15, and 18 are claimed in claim 9 of Application No. 10/767,482. The structural features of pending claim 6 are claimed in claim 1 of Application No. 10/767,482.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Pinczykowski (US 4,892,238 A).

Regarding claim 1, Pinczykowski discloses a clip (10) adapted for use in connection with an article (40), the clip defining a pair of rigid spaced-apart arms (16,18,22,24), the article defining a shell and an interior and the clip being adapted to be located within the interior of the article in a relationship wherein the arms protrude through openings defined in the shell of the article (Figure 4), the article further defining a pair of sleeves (42,44) extending outwardly from said openings defined in the shell and the arms of said clip being adapted to extend through said sleeves respectively. The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Pinczykowski which is capable of being used in the intended manner, i.e., the article being carried by a user and the spaced-apart arms resting or engaging against a user's waist, hips, or back. There is no structure in Pinczykowski that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 5, the clip arms of Pinczykowski are formed with a metal core (32) such that they can be bent into various configurations. If a certain stress was applied to the arms where the stress is below the yield strength of the metal, all deformation seen in the arms due to that stress would be recoverable and the arms would spring back to their initial position. The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Pinczykowski which is capable of being used in the intended manner, i.e., arms exerting a compressive force against the waist and/or hips of a user. There is no structure in

Pinczykowski that would prohibit such functional intended use (see MPEP 2111). Note that the arms could be bent in a direction out of the page as shown in Figure 4, into a generally U-shaped configuration that would correspond to a user's waist and/or hips, at which point the above-mentioned stress could be applied to the arms such that they would spring back to their original bent positions and apply a compressive force on the user.

Regarding claim 6, the claim combines limitations of claims 1 and 5 that have already been shown above to be unpatentable over Pinczykowski.

Regarding claim 7, the clip and article of Pinczykowski as applied to claim 1 above includes the claimed features, the article (40) of Pinczykowski further including a front face (outer fabric surface of article) on which the pair of outwardly extending sleeves are defined. Examiner notes that several accepted definitions of the word "face" read, "the surface: *the face of the earth*" and "the outer or upper side of a fabric; right side" "face." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 19 Jan. 2007. <Dictionary.com <http://dictionary.reference.com/browse/face>>. Therefore, the exterior or outer surface of the article as a whole can be considered a front face of the article while the interior or inner surface of the article as a whole can be considered a rear face of the article. There is currently no structure in the claim that defines over this interpretation.

Regarding claim 8, the claim includes limitations directed to a compressive force like those of claim 5 that have already been shown above to be unpatentable over Pinczykowski.

Regarding claim 9, the clip of Pinczykowski includes a body (12) interconnecting said pair of arms.

5. Claims 1, 5-8, 15, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson (US 5,890,640 A).

Regarding claims 1, 7, and 15, Thompson discloses a pack adapted to be carried by a user and comprising a shell defining an outer surface and a hollow interior and a support member (26/28) located within the interior of the pack and defining a pair of spaced-apart arms extending through apertures defined in the outer surface of said pack, said arms being adapted to abut the waist, hips and/or back of the user, and a pair of sleeves (44,46) in communication with said apertures defined in the outer surface of said pack, said arms of said support member extending through the sleeves.

Regarding claims 5, 6, and 8, the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Thompson which is capable of being used in the intended manner, i.e., the arms exerting a compressive force on a user. There is no structure in Thompson that would prohibit such functional intended use (see MPEP 2111). The arms of Thompson are disclosed as being resilient, meaning that they spring back to their original shape when deformed, and are thus capable of exerting a compressive force on the waist, hips, and/or back of a user.

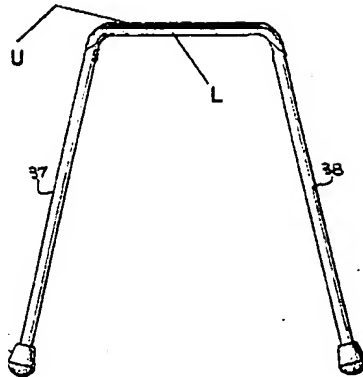
Regarding claim 17, the support member of Thompson defines a clip including a base (68) located within the interior of the pack, said arms extending from said base and being adapted to flex outwards and away from each other.

Regarding claim 18, the arms of Thompson are collapsible to the degree that if enough force were placed on them, they would break or give in.

6. Claims 12, 21-26, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Buck, Jr. et al. (US 4,054,256 A).

Regarding claim 12, Buck, Jr. et al. disclose a support member (20) adapted for use with a golf bag defining an outer surface and including a handle (19) defining a central through opening (35), the support member defining a clip suspended from the through opening of the handle of the golf bag, the clip being pivotable about the handle between a first position (Figure 1) wherein said arms are positioned adjacent the outer surface of the bag and a second position (Figure 5) wherein the clip and the arms thereof have been rotated away from the outer surface. The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Buck, Jr. et al. which is capable of being used in the intended manner, i.e., a user grasping the portion (14) for carrying the golf bag and the arms engaging the waist and/or hips of a user when in the second position. There is no structure in Buck, Jr. et al. that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 21, the support member of Buck, Jr. et al. satisfies the limitations of the claim when considered in the following manner: The support member of Buck, Jr. et al. includes a pair of arms (37,38) defined by a frame of a continuous bar of material, wherein the frame has an upper portion (U, below) from which the arms depend and a lower portion (L, below) extending between the arms and defining a notch.



The initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentably distinguishing structure over that disclosed by Buck, Jr. et al. which is capable of being used in the intended manner, i.e., the arms engaging the waist and/or hips of a user carrying the golf bag. There is no structure in Buck, Jr. et al. that would prohibit such functional intended use (see MPEP 2111).

Regarding claim 22, the support member (20) of Buck, Jr. et al. is adapted to be secured to the handle (14) of the golf bag.

Regarding claim 23, the claim contains limitations directed to positions of the arms like those of claim 12 that have already been shown above to be unpatentable over Buck, Jr. et al.

Regarding claim 24, Examiner is of the position that the arms of Buck, Jr. et al. are inherently flexible towards and away from each other as they are relatively thin rods of material. Any such rod of material may be bent or flexed to at least some degree.

Regarding claim 25, the arms of Buck, Jr. et al. are angled in such a way that if a user were to press their waist in between the legs in a direction towards the golf bag, the angled arms would certainly apply a compressive force against the user as the



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distance between the arms gets smaller as you get closer to the golf bag, effectively satisfying the limitations of the claim.

Regarding claim 26, Buck, Jr. et al. disclose that the support member is made from lightweight aluminum alloy (col. 5 lines 13-16). Examiner is of the position that aluminum alloy, when stressed within its yield strength, will return to its original shape, thus making it a "shape memory material". Examiner notes that in Applicant's specification, "shape memory material" is only generally equated to an alloy, further supporting Examiner's position that aluminum alloy is a shape memory material.

Regarding claim 30, the frame of Buck, Jr. et al. is surrounded on its ends by protective sleeves (37a,38a) where the sleeves each define a notch into which an end of the frame is received.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buck, Jr. et al. as applied above in view of Chen (US 5,351,921 A).

The support member of Buck, Jr. et al. includes the claimed features except for a strap extending between and interconnecting the arms, the arms being pivotable towards each other in response to the lateral movement of the strap. Chen, however, also discloses a support member for a golf bag, the support member including a pair of

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arms (4), and teaches that an adjustable strap (35) extends between and interconnects the arms, further connecting them to the golf bag in order to adjust the degree to which the arms can be extended from the golf bag (col. 3 line 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a strap between the arms of Buck, Jr. et al., as taught by Chen, so that a user could adjust the degree to which the arms were able to extend from the golf bag to their preference.

***Allowable Subject Matter***

9. Claim 19 is allowed.

***Response to Arguments***

10. Applicant's arguments filed 10/14/06 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 7am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML  
2/5/07

  
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